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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,507	12/05/2001	Christoph Rudinger	RUDINGER ET AL -5 (PCT)	5008
25889	7590	12/05/2003	EXAMINER MANOHARAN, VIRGINIA	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ART UNIT 1764	PAPER NUMBER

10

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

010

Office Action Summary

Application No.

10/009,507

Applicant(s)

RUDINGER ET AL.

Examiner

Virginia Manoharan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other: _____

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors e.g., typographical, grammar, idiomatic, syntax and etc. Applicants' cooperation's are requested in correcting any errors of which applicants may become aware in the specification.

Claims 18-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The preamble of claim 18 provides for ambiguity relative to the extraction step, i.e., whether to consider as part of applicants' invention or not?

The claims should be amended to a Jepson-type-format (if intended) in accordance with rule 1.75(e) to delineate that which is considered to be an improvement in the art.

B) The term "pure" and "small" in claims 18 and 29 are relative terms, which render the claims indefinite. The specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Replacing e.g., the term "pure" with – purified – obviates this rejection. See also claims 31 & 32.

C) In claim 29, "in such a way" is indefinite as the way has not been defined.

D) The inconsistent used of terminology in the claims is improper. For example: "intermediate distillation column (29)" in claim 30 as opposed to "column (29)" in claim 18, the claim from which it depends. The same holds true for claims 31 & 33. See also

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the "solvent stripping column (11) in claim 18 as opposed to solvent distillation column (11) in claim 33.

E) There are no proper antecedent basis for supports in the claims for the following recitations:

- 1) "the formic acid distillation column (33)" in claim 33;
- 2) "the heat of reaction ", claim 34;
- 3) " the upstream reaction ", claim 34;
- 4) "the acetic acid distillation column (5)", claim 34; and
- 5)" the formic acid distillation column (33) ", claim 34;

F) The parenthetical expression such as (mixture (B)) in claim23 renders the claim ambiguous i.e., whether or not the expression should be disregarded.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18 – 35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 - 25 of copending Application No. 10/030,533. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the subject matter of the instant claims are covered in the claims of the above copending application and vice versa.

This is a provisional obviousness-type- double patenting rejection because the conflicting claims have not in fact been patented.

Claims 18 – 35 are provisionally rejected under the judicially created doctrine of double patenting over claims 13 – 25 of copending Application No. 10/030,533. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: inter alia, a process for the separation and purification of an aqueous mixture comprising acetic acid, formic acid and high boilers by extraction with a solvent in a circulation process including the steps of feeding a raffinate stream to a solvent stripping column for removal of water, and conveying an extract stream to a solvent distillation column wherein the solvent used is selected from the group consisting of saturated hydrocarbons having from 4 to 8 carbon.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 18-34 are allowable over the prior art of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Horlenko discloses a distillation process for recovering formic acid from aqueous solution.

b. Berg et al '690 and Honma et al both disclose a dehydration process.

c. Preusser et al both disclose an extraction process that is coupled to a distillation process.

d. Hofer et al discloses a process for the preparation of organic solutions of percarboxylic acids.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 703-308-3844. The examiner can normally be reached on Tuesday-Friday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-4311. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



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